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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,084	04/18/2001	Andrea Maylene Carlson	1048-1139.1	8414

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06/19/2003

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

7

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/837,084

Applicant(s)

CARLSON ET AL.

Examiner

Lawrence D Ferguson

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1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment mailed January 21, 2003.

Claim 2 was canceled, claims 1,3,4,5,7-9,11-12 and 14 were amended and claims 15-20 were added, rendering claims 1 and 3-20 pending.

***New Matter - 35 U.S.C. 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. 'an image positioned on a surface' is not supported by the specification.

***Claim Rejections – 35 USC § 103(a)***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 3-4, 6-11 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramesh (U.S. 6,346,285) in view of Kobayashi et al. (U.S. 5,643,659).

6. Ramesh discloses a packaging film comprising a first layer of polyamide, a second layer of polyamide and a third layer which serves as an oxygen barrier layer (column 2, lines 16-54) where the oxygen barrier layer is the inner layer (column 15, lines 16-20). The reference further discloses a fourth outer layer comprising polyester (column 3, lines 23-32) where the multilayer film is biaxially oriented containing a layer of polyolefin (column 3, lines 25-39). Ramesh discloses an extruded film (column 4, lines 23-24) consisting of a blend of polyamide of semi-crystalline polyamide and an amorphous polyamide (column 14, lines 40-64). Ramesh discloses bonding the layers of the coextruded multilayer film together with adhesives (column 6, lines 24-32). In claims 1 and 16, the phrase ‘...so as to cover and protect said image’ is directed to intended use. In response to applicant’s argument that [ 1 ], a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from

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the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Ramesh does not explicitly disclose the film being flexible. Ramesh discloses a film that is in direct contact between the product and the surface of the film (column 5, lines 3-7). Because the film takes on the shape of the product, it would have been obvious to one of ordinary skill in the art that the film disclosed in Ramesh is flexible, absent any evidence to the contrary. Ramesh does not disclose the exact arrangement of the oxygen barrier layer between the two polyamide layers. It would have been obvious to one of ordinary skill in the art to rearrange these layers since rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Ramesh does not disclose an image on the surface of the multilayered film.

Kobayashi teaches an image on the surface of a multilayer article having a protective layer film covering the image comprised of polyamide (column 5, lines 1-10). Ramesh and Kobayashi are analogous art because they are both from the field of multilayered films. It would have been obvious to one of ordinary skill in the art to include a printed image on the outer layer of Ramesh's film in order to identify the product of the packaged film and Kobayashi teaches the protective polyamide layer film to improve heat resistance and abrasion resistance.

***Claim Rejections – 35 USC § 103(a)***

7. Claims 5, 12 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramesh (U.S. 6,346,285) in view of Kobayashi et al. (U.S. 5,643,659) further in view of Kuriu et al. (U.S. 5,562,996).
8. Ramesh in view of Kobayashi is relied upon for claims 1 and 3-4, 6-11 and 13-18. Ramesh does not disclose an oxygen barrier layer sandwiched between first and second polyamide layers. Kuriu teaches a multilayered film comprising a gas barrier layer sandwiched between two polyamide layers with adhesive layer(s) binding them (column 5, lines 4-22). All of the references are analogous because they are from the field of multilayered films. It would have been obvious to one of ordinary skill in the art to include the oxygen barrier layer of Ramesh sandwiched between the two polyamide layers of Ramesh because Kuriu teaches this arrangement of the layers within a multilayered film, as presently disclosed in instant claims 5, 12, 19 and 20.

***Response to Arguments***

9. Rejection of claims 1, 5 and 7-14 under 35 USC 112, second paragraph has been withdrawn due to Applicant's arguments and amendment to the claims.

Applicant's arguments of rejection under 35 USC 10e(e) as anticipated by Ramesh, U.S. Patent No. 6,346,285 are moot based on grounds of new rejection.

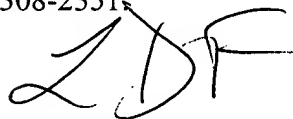
Product by process rejections are withdrawn due to Applicant's arguments and amendment to the claims.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)

308-2351



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
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